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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,014	12/27/2005	Russell Lee Marks	113-012	9096
47533 7590 01/02/2008 INTELLECTUAL PROPERTY LAW OFFICE OF JOEL VOELZKE 24772 SADDLE PEAK ROAD MALIBU, CA 90265			EXAMINER LYJAK, LORI LYNN	
			ART UNIT 3612	PAPER NUMBER
			MAIL DATE 01/02/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/535,014

Applicant(s)

MARKS ET AL.

Examiner

Lori L. Lyjak

Art Unit

3612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41, 50, 52, 58-61, 63-65 and 67-72 is/are rejected.
- 7) ☒ Claim(s) 42-49, 51, 53, 54, 56, 57, 62, 66 and 69 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. Claims 41, 50, 52, 58-61, 63-65 and 67-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. 5,564,770 in view of WO 90/01999.

Regarding claim 41, Smith et al. '770 discloses a vehicle immobilization device for securing to a vehicle windscreen, comprising: a screen (24) which, when the device is in an in-use disposition on the vehicle windscreen, serves to impair a driver's view through the windscreen, wherein the screen is changeable from a first configuration to a second configuration, the first configuration being more compact than the second configuration; a grip for holding said screening means in said in-use disposition on said windscreen by suction

(25 and 28) but does not show a release mechanism for enabling release of the suction of said grip so as to allow removal of the device from the windscreen; and security mechanism for preventing unauthorized operation of said releasing means.

WO '999 teaches a plate rigidly attached in the suction cup, and with the aid of manually operated means (23, 2, 14, 12) the suction cup is activated so that its retaining force will be greater than the rupture limit of the material is the object to be protected against theft.

Regarding claim 41, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the suction cups of Smith et al. '770 with a release mechanism and security mechanism, as taught by WO '999 in order to protect against theft.

Regarding claim 50, Smith et al. '770, as modified, discloses the vehicle immobilization device as claimed in claim 41, comprising a grip protector for preventing access to said grip from the under-side of the device facing the windscreen when in said in-use disposition.

Regarding claim 52, Smith et al. '770, as modified, discloses the vehicle immobilization device as claimed in claim 41, wherein said device assumes a substantially flat profile when in said in-use disposition.

Regarding claim 58, Smith et al. '770, as modified, discloses the vehicle immobilization device as claimed in claim 41, wherein said screen means comprises rubber.

Regarding claim 59, Smith et al. '770, as modified, discloses the vehicle immobilization device, wherein the screen further comprises a plurality of rigid formings.

Regarding claim 60, Smith et al. '770, as modified, discloses the vehicle immobilization device as claimed claim 58, wherein said screening means is sonically welded to the suction grip means.

Regarding claim 61, Smith et al. '770, as modified, discloses the vehicle immobilization device as claimed in claim 41, where said grip comprises one or more suction cups.

Regarding claim 63, Smith et al. '770, as modified, discloses a method for securing a vehicle immobilization device as claimed in claim 41, to a vehicle windscreen, comprising the steps of: changing said screen from said first configuration to said second configuration; arranging said screen on the vehicle windscreen in said in-use disposition so as to impair a driver's view through the windscreen; activating said grip means so as to hold said screening means in said in-use disposition on said windscreen by means of suction; and activating said security mechanism so as to prevent unauthorized operation of said release mechanism.

Regarding claim 64, Smith et al. '770, as modified, the method as claimed in claim 63, wherein said screen is said vehicle windscreen such that the center of the screening means is substantially in the driver's line of vision.

Regarding claim 65, Smith et al. '770, as modified, the method as claimed in claim 63, wherein the vehicle immobilization device is placed on the exterior of the vehicle windscreen.

Regarding claim 67, Smith et al. '770, as modified, discloses the method for removing a vehicle immobilization device secured to a vehicle windscreen by a method as claimed in claim 63, comprising the steps of: de-activating said security mechanism so as to enable operation of said release mechanism; operating said released mechanism to deactivate said suction grip means; removing the vehicle immobilization device from the vehicle windscreen; and changing said screen from said second configuration to said first configuration.

Regarding claim 68, Smith et al. '770, as modified, discloses the method of preventing a vehicle from being driven away, comprising attaching a device as claimed in claim 41 to a vehicle windscreen.

Regarding claim 69, Smith et al. '770, as modified, discloses the screen of a vehicle immobilization device, the screen being changeable from a first configuration to a second configuration, the first configuration being more compact than the second configuration and having means for allowing engagement with a grip of the device.

Regarding claim 70, Smith et al. '770 discloses a vehicle immobilization device for securing to a vehicle windscreen, comprising: screening means which, when the device is in an in-use disposition on the vehicle windscreen, serves to impair a driver's view through the windscreen, wherein the screening means is changeable from a first configuration to a second configuration, the first configuration being more compact than the second configuration; suction grip means for holding said screening means in said in-use disposition on said windscreen by suction but does not show releasing means for enabling release of the suction of said suction grip means so as to allow removal of the device from the windscreen; and security means for preventing unauthorized operation of said releasing means.

WO '999 teaches a plate rigidly attached in the suction cup, and with the aid of manually operated means (23, 2, 14, 12) the suction cup is activated so that its retaining force will be greater than the rupture limit of the material is the object to be protected against theft.

Regarding claim 70, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the suction cups of Smith et al. '770 with a release mechanism and security mechanism, as taught by WO '999 in order to protect against theft.

Regarding claim 71, Smith et al. '770, as modified, discloses the method for securing a vehicle immobilization device as claimed in claim 70 to a vehicle windscreen, comprising the steps of: changing said screening means from said first configuration to said second configuration; arranging said screening means on the vehicle windscreen in said in-use disposition so as to impair a driver's view through the windscreen; activating said grip means so as to hold said screening means in said in-use disposition on said windscreen; and activating said security means so as to prevent unauthorized operation of said releasing means.

Regarding claim 72, Smith et al. '770, as modified, discloses the method for removing a vehicle immobilization device secured to a vehicle windscreen by a method as claimed in claim 71, further comprising the steps of: de-activating said security means so as to enable operation of said releasing means; operating said releasing means to deactivate said suction grip means; removing the vehicle immobilization device from the vehicle windscreen; and changing said screening means from said second configuration to said first configuration.

Claim Objection

4. Claim 59 is objected to because of the following informalities:

Claim 59 depends from cancelled claim 18.

Appropriate correction is required.

Allowable Subject Matter

5. Claims 42-49, 51, 53, 54, 56, 57 62, 66 and 69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lori L. Lyjak whose telephone number is 571-272-6658.

The examiner can normally be reached on Monday-Friday 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on 571-272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lori L. Lyjak/
Primary Examiner
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December 20, 2007